



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/534,607

05/11/2005

Takesi Nakamura

05312/HG

6847

1933

7590

12/13/2005

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
767 THIRD AVENUE
25TH FLOOR
NEW YORK, NY 10017-2023

EXAMINER

LETSCHER, GERALDINE

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/534,607

Applicant(s)

NAKAMURA, TAKESI

Examiner

Geraldine V. Letscher

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5-11-05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102 and 103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6, 8 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshida et al. (U.S. Patent No. 6,569,610).

Yoshida et al. discloses a silver halide photographic material comprising a polyethylene laminated paper support (column 33, line 40) having thereon one or more light-sensitive silver halide emulsion layers, characterized in that a light-insensitive hydrophilic colloid layer is between the light-sensitive layer closest to the support and said support, wherein said light-insensitive hydrophilic colloid layer contains a titanium oxide (column 33, line 42), and further characterized in that the light-sensitive layer closest to the support is a blue-sensitive layer containing silver halide grains having an average grain size (column 33, line 52) inclusive of the instant claims.

Although Yoshida et al. does not specify the image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a

Art Unit: 1752

particular L-size of said material, since a composition of matter is claims, i.e., a silver halide photographic material, and Yoshida et al. discloses said silver halide photographic material, it is asserted that the silver halide photographic material inherently possess the recited image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, and that the claimed photographic material lacks novelty, absent object evidence to the contrary. Assuming arguendo that Yoshida et al. does not inherently possess the recited image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, then Yoshida et al. is also relied upon under 35 USC 103, because it would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to vary the L-size of the prior art photographic material and process said material, with reasonable expectations of achieving, absent object evidence to the contrary, the advantages generally taught therein.

4. Claims 1, 4-6, 8 and 11-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ueda et al. (U.S. Patent No.).

Ueda et al. discloses a silver halide photographic material comprising a polyethylene laminated paper support (column 12, line 22) having thereon one or more light-sensitive silver halide emulsion layers, characterized in that a light-insensitive hydrophilic colloid layer is between the light-sensitive layer closest to the support and

Art Unit: 1752

said support, wherein said light-insensitive hydrophilic colloid layer contains a latex, a lipophilic compound and or a titanium oxide (column 12, line 30+), and further characterized in that the light-sensitive layer closest to the support is a blue-sensitive layer (column 13, line 45) containing silver halide grains having an average grains size inclusive of the instant claims.

Although Ueda et al. does not specify the image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, since a composition of matter is claims, i.e., a silver halide photographic material, and Ueda et al. discloses said silver halide photographic material, it is asserted that the silver halide photographic material inherently possess the recited image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, and that the claimed photographic material lacks novelty, absent object evidence to the contrary. Assuming arguendo that Ueda et al. does not inherently possess the recited image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, then Ueda et al. is also relied upon under 35 USC 103, because it would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to vary the L-size of the prior art photographic material and process said material, with reasonable expectations of achieving, absent object evidence to the contrary, the advantages generally taught therein.

5. Claims 1, 3, 6, 8, 10 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Deguchi et al. (U.S. Patent No. 5,415,982).

Example 1 of Deguchi et al. discloses a silver halide photographic material comprising a polyethylene laminated paper support (column 53, line 65) having thereon one or more light-sensitive silver halide emulsion layers, characterized in that a light-insensitive hydrophilic colloid layer is between the light-sensitive layer closest to the support and said support, wherein said light-insensitive hydrophilic colloid layer contains a thiosulfinic acid compound and/or a titanium oxide, and further characterized in that the light-sensitive layer closest to the support is a blue-sensitive layer containing silver halide grains having an average grains size inclusive of the instant claims.

Although Deguchi et al. does not specify the image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, since a composition of matter is claims, i.e., a silver halide photographic material, and Deguchi et al. discloses said silver halide photographic material, it is asserted that the silver halide photographic material inherently possess the recited image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, and that the claimed photographic material lacks novelty, absent object evidence to the contrary. Assuming arguendo that Deguchi et al. does not inherently possess the recited image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, then

Deguchi et al. is also relied upon under 35 USC 103, because it would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to vary the L-size of the prior art photographic material and process said material, with reasonable expectations of achieving, absent object evidence to the contrary, the advantages generally taught therein.

6. Claims 1 and 5- 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Nakamura (U.S. Patent No. 5,578,426) or Fukuzawa et al. (U.S. Patent No. 5,328,818).

The examples of each of Nakamura and Fukuzawa et al. discloses a silver halide photographic material comprising a polyethylene laminated paper support having thereon one or more light-sensitive silver halide emulsion layers, characterized in that a light-insensitive hydrophilic colloid layer is between the light-sensitive layer closest to the support and said support, wherein said light-insensitive hydrophilic colloid layer contains a lipophilic compound, a titanium oxide and/or a colloidal silver.

Although Nakamura and Fukuzawa et al. do not specify the image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, since a composition of matter is claims, i.e., a silver halide photographic material, and each of Nakamura and Fukuzawa et al. discloses said silver halide photographic material, it is asserted that the silver halide photographic material inherently possess the recited image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a

Art Unit: 1752

particular L-size of said material, and that the claimed photographic material lacks novelty, absent object evidence to the contrary. Assuming *arguendo* that each of Nakamura and Fukuzawa et al. does not inherently possess the recited image clarity (C-value) of the processed photographic material, as determined using an optical wedge, utilizing a particular L-size of said material, then each of Nakamura and Fukuzawa et al. is also relied upon under 35 USC 103, because it would have been obvious to one of ordinary skill in the requisite art at the time the invention was made to vary the L-size of the prior art photographic material and process said material, with reasonable expectations of achieving, absent object evidence to the contrary, the advantages generally taught therein.

7. Claims 1,2 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zorn et al. (U.S. Patent No. 3,945,829) in view of Nakamura (U.S. Patent No. 5,578,426).

The examples in Zorn et al. (columns 7-8) discloses a silver halide photographic material comprising a support having thereon one or more light-sensitive silver halide emulsion layers, characterized in that a light-insensitive hydrophilic colloid layer is between the light-sensitive layer closest to the support and said support, wherein said light-insensitive hydrophilic colloid layer contains a mercapto-heterocyclic compound, a lipophilic compound and/or a titanium oxide. However, Zorn et al. does not exemplify the use of a polyethylene laminated paper support.

Art Unit: 1752

Nakamura is relied upon for its teaching of a silver halide photographic material comprising a polyethylene laminated paper support having thereon one or more light-sensitive silver halide emulsion layers, characterized in that a light-insensitive hydrophilic colloid layer is between the light-sensitive layer closest to the support and said support, wherein said light-insensitive hydrophilic colloid layer contains a lipophilic compound, a titanium oxide and/or a colloidal silver.

It would have been obvious to one of ordinary skill in the requisite art at the time the invention was made incorporate a polyethylene laminated paper support as taught in Nakamura into the photographic material of Zorn et al. , and to subsequently vary the L-size of the prior art photographic material prepared with the combined teachings of Zorn et al. and Nakamura and process said material, with reasonable expectations of achieving, absent object evidence to the contrary, the advantages generally taught therein.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldine V. Letscher whose telephone number is (571) 272-1334. The examiner can normally be reached 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1752

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Geraldine Letscher', with a stylized, cursive script.

**GERALDINE LETSCHER
PRIMARY EXAMINER
GROUP 1100**